

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 24.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

Ex parte ALGIRDAS A. UNDERYS

JUL 18 2002

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Appeal No. 2001-0359
Application No. 08/991,113

ON BRIEF

Before WINTERS, HANLON, and POTEATE, Administrative Patent Judges.
HANLON, Administrative Patent Judge.

REMAND TO THE EXAMINER

Our consideration of this record leads us to conclude that the case is not in condition for a decision on appeal. Accordingly, we remand the application for the examiner to consider the following issues and take appropriate action.

Background

Claims 4, 6 through 9 and 15 through 17 stand finally rejected under 35 U.S.C. § 112, first paragraph, based on written

description.¹ The claims are directed to a method of heat treating bars, blocks and other tool steel workpieces. Claims 15 and 16 are illustrative and read as follows:

15. In a method of heat treating bars, blocks and other tool steel workpieces the steps of
 providing a heat treatment furnace of a size
 suitable to receive a tool steel workpiece to be heat
 treated,
 providing a heat source in the interior of the
 furnace consisting of a source of infrared heat energy,
 subjecting the tool steel workpiece to heat
 treatment by exposing said tool steel workpiece to
 infrared heat energy from the infrared heat energy source
 and
 maintaining said tool steel workpiece stationary
 during subjection of the workpiece to heat treatment from
 the infrared energy source.

16. In a method of heat treating bar, block and other tool steel workpieces the steps of
 providing a heat treatment furnace of a size
 suitable to receive tool steel workpiece to be heat
 treated,
 providing a source of infrared heat energy in the
 interior of the furnace consisting of tungsten halogen
 lamp means,
 subjecting the tool steel workpiece to heat
 treatment by exposing said tool steel workpiece to
 infrared heat energy from the tungsten halogen lamp means
 and

¹The examiner notes that neither the first page of the final rejection (Paper No. 4) nor any of the subsequent advisory actions (Paper Nos. 7, 10, 12 and 19) expressly state that claims 6 through 9 are rejected. See Answer, p. 2. Nevertheless, in the brief appellant correctly recognizes that claims 6 through 9 stand rejected under 35 U.S.C. § 112, first paragraph. See Brief, p. 1.

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maintaining said tool steel workpiece stationary during subjection of the workpiece to heat treatment from the infrared energy source.

In the final rejection, the examiner explained that subject matter recited in claims 15 and 16 relating to treatment of "bars" or a "block" and the "maintaining" step recited in claims 15 and 16 are not supported by the original disclosure. See Paper No. 4, p. 2. Therefore, the examiner maintained the rejection under 35 U.S.C. § 112, first paragraph, based on written description.

Appellant filed an appeal brief wherein the issues on appeal were outlined as follows (Brief, p. 3):

A. Did the application as filed convey to a man skilled in the art the concept that tool steel blocks, as well as tool steel bars and tool steel rods, were described in the application in a manner sufficient to meet the written description requirement of the first paragraph of 35 U.S.C. 112.

B. Did the application as filed convey to a man skilled in the art the concept that the tool steel workpieces were maintained stationary during treatment in a manner sufficient to meet the written description requirement of the first paragraph of 35 U.S.C. 112.

In the answer, the examiner conceded that the evidence of record establishes that the disclosure of the application, as originally filed, provides descriptive support for the "block" recited in claims 15 and 16. The examiner concluded that "the sole

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remaining issue in this appeal is issue (B) on page 3 of the Brief, regarding workpieces 'maintained stationary'."² See Answer, p. 3.

Appellant did not file a reply brief. The application file, including the appeal brief and the examiner's answer, was transmitted to the Board whereby jurisdiction passed from the examiner to the Board. See 37 CFR § 1.191(e) (2001).

On March 4, 2002, approximately one and one-half years after the answer was mailed, appellant filed a paper entitled "AMENDMENT" (Paper No. 23) proposing certain amendments to claims 15 and 16. In the paper, appellant alleges that a telephone discussion with the examiner took place on February 11, 2002, an unofficial paper entitled "UNOFFICIAL PAPER FOR DISCUSSION ONLY" was submitted by telefax on February 15, 2002,³ and another telephone discussion with the examiner took place on February 20, 2002. Paper No. 23, p. 2. According to appellant, at the conclusion of the discussion on February 20, 2002, the examiner agreed that amendments to claims 15 and 16 contained in the "unofficial" paper submitted on February 15, 2002, overcame the rejection of claims 15 and 16 and the claims

²Presumably, whether or not the disclosure of the application, as originally filed, provides descriptive support for the subject matter recited in claims 15 and 16 relating to treatment of "bars" is no longer an issue in this appeal.

³A copy of "UNOFFICIAL PAPER FOR DISCUSSION ONLY" cannot be located in the official file wrapper of Application 08/991,113.

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dependent thereon. Paper No. 23, pp. 2-3. The paper entitled "AMENDMENT" followed, amending claims 15 and 16 "as discussed." Paper No. 23, p. 3. The paper has not been entered. See 37 CFR § 1.116(d) (2001) ("No amendment can be made as a matter of right in appealed cases.").

Remand

Prior to rendering a decision on the merits, we believe it would be prudent for the examiner, in the first instance, to consider whether or not to enter Paper No. 23 entitled "AMENDMENT." Therefore, the application is remanded to the examiner solely for that purpose.

As we see it, upon return of the application to the jurisdiction of the examiner there are three available alternatives:

1. Enter Paper No. 23 entitled "AMENDMENT," withdraw the application from appeal and, if appropriate, pass the application to issue.

2. Enter Paper No. 23 entitled "AMENDMENT" and return the application to the Board. If this alternative is selected, the examiner is instructed to explain why the rejection, based on written description, applies to claims 15 and 16 as amended in

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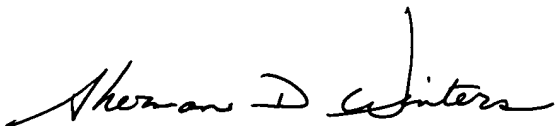


Paper No. 23. In this instance, we authorize a supplemental answer pursuant to the provisions of 37 CFR § 1.193 (2001).

3. Deny entry of Paper No. 23 entitled "AMENDMENT" and return the application to the Board. If this alternative is selected, the appeal will be decided on the administrative record as of August 11, 2000, which includes the appeal brief (Paper No. 21) and the examiner's answer (Paper No. 22).

Conclusion

This application, by virtue of its "special" status, requires an immediate action. MPEP § 708.01 (8th ed., Aug. 2001), item (D). It is important that the Board be informed promptly of any action affecting the appeal in this case.

REMAND

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| SHERMAN D. WINTERS |) | |
| Administrative Patent Judge |) | |
|  |) | |
| ADRIENE LEPIANE HANLON |) | BOARD OF PATENT |
| Administrative Patent Judge |) | APPEALS |
|  |) | AND |
| LINDA R. POTEATE |) | INTERFERENCES |
| Administrative Patent Judge |) | |

ALH/lp

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